

REMARKS

This responds to the Office Action mailed on March 22, 2005, and the references cited therewith.

No claims are amended or cancelled. Claims 1-20 remain pending in this application.

§102 Rejection of the Claims

Claims 1-6 and 17-19 were rejected under 35 U.S.C. § 102(b) for anticipation by Shock (U.S. Patent No. 3,942,519). The rejection states that “Shock discloses an instrument comprising a gripping portion 24, a small diameter instrument portion 14 having a length extending from the gripping portion, and a support member 26 engaging the small diameter instrument portion 14 along the length, providing lateral support, wherein an unsupported distal portion of the length is adjustable.” Applicant respectfully traverses the rejection for at least the following reasons.

Shock appears to show an instrument 12 having a housing 24. Shock also appears to show a tool 14 that may be a needle like member. A shank portion 26 includes a face surface 50. The shank portion 26 of Shock appears to provide ultrasonic motion with respect to the housing 24 as indicated by double headed arrow 45. However Applicant is unable to find in Shock, a support member that engages the small diameter instrument portion along the length, providing lateral support, wherein an unsupported distal portion of the length is adjustable.

In contrast, claim 1 includes a support member that engages the small diameter instrument portion along the length, providing lateral support, wherein an unsupported distal portion of the length is adjustable. Applicant respectfully submits that in contrast to support, the shank portion 26 of Shock provides vibration. Further, in contrast to an unsupported distal portion of the length being *adjustable*, Shock states in column 7, lines 31-36 that the tool 14 (via threaded stud 58) makes a *rigid connection* to the shank portion 26 (via face surface 50). Any unsupported portion of the tool 14 in Shock therefore appears to be fixed.

Regarding independent claim 6, the rejection states that “Shock discloses the adjustment means as indicated by double headed arrow 45 for adjusting the support member.” However, as discussed above, Applicant respectfully submits that motion indicated by double headed arrow

45 does not adjust an amount of support, nor does the shank portion 26 provide support at all. The motion indicated by double headed arrow 45 appears to provide vibration.

In contrast, claim 6 includes support means to provide lateral support for the small diameter instrument portion along the length, and adjustment means for adjusting an amount of support for the small diameter instrument portion.

Regarding independent claim 17, the rejection states that the Shock device is inherently capable of performing the recited steps. Applicant respectfully traverses this rejection. Similar to arguments presented above, Applicant respectfully submits that the device of Shock does not provide lateral support to a distal end of a small diameter instrument portion. Further, Applicant respectfully submits that the device of Shock does not adjust a position of lateral support relative to a small diameter instrument portion to allow deeper insertion of the small diameter instrument portion into an eye.

In contrast, independent claim 17 includes providing lateral support to a distal end of a small diameter instrument portion, and adjusting a position of lateral support relative to the small diameter instrument portion to allow deeper insertion of the small diameter instrument portion into an eye.

Because the Shock reference does not show every element of Applicant's independent claims, a 35 USC § 102(b) rejection is not supported. Reconsideration and withdrawal of the rejection is respectfully requested with respect to Applicant's independent claims 1, 6, and 17. Additionally, reconsideration and withdrawal of the rejection is respectfully requested with respect to the remaining claims that depend therefrom as depending on allowable base claims.

§103 Rejection of the Claims

Claims 7-16, and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Shock in view of Evvard (U.S. Patent No. 3,736,938). The rejection states that Evvard discloses a cylinder 25 that serves as a sheath for the small diameter instrument 18.

Applicant respectfully submits that the additional reference of Evvard fails to cure the rejection based on Shock for at least the reasons outlined above. Evvard appears to show a

housing 25 that serves as a sheath for a rod 18. Evvard also appears to show an “axially vibrating member 27” (col. 2, line 35) that is directly connected to the housing 25. Further, location of the housing 25 with respect to the rod 18 appears to be fixed by elements such as the support bracket 15 and the coupling 19. Evvard does not show a cylinder surrounding a part of a small diameter instrument portion along a length, *the cylinder being slidable along the length*. Evvard also does not show a strut connected between the cylinder and a gripping portion to *provide flexural support* to at least part of the small diameter instrument portion, and to move the cylinder to various locations along the length.

In contrast, independent claim 7 includes a cylinder surrounding a part of a small diameter instrument portion along the length, the cylinder being slidable along the length. Evvard also does not show a strut connected between the cylinder and the gripping portion to provide flexural support to at least part of the small diameter instrument portion, and to move the cylinder to various locations along the length. Applicant respectfully submits that in contrast to support, vibration is provided by the “axially vibrating member 27.” Further, in contrast to a cylinder that is slidable along a length, the housing 25 is fixed along a length of the rod 18.

Because Shock and Evvard, either alone or in combination, do not show every element of Applicant’s independent claims, a 35 USC § 103(a) rejection is not supported by the references. Reconsideration and withdrawal of the rejection is respectfully requested with respect to Applicant’s independent claim 7. Additionally, reconsideration and withdrawal of the rejection is respectfully requested with respect to the remaining claims that depend therefrom as depending on an allowable base claim.

Claim 20 depends from independent claim 17 as argued above. Applicant respectfully submits that claim 20 is therefore in condition for allowance at least as depending from an allowable base claim.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6944 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

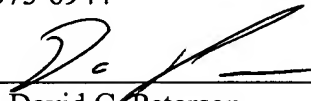
Respectfully submitted,

EDWIN RYAN

By his Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 373-6944

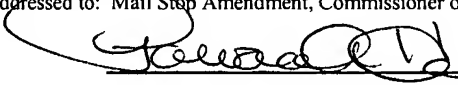
Date 4-15-05

By 
David C. Peterson
Reg. No. 47,857

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 5th day of April, 2005.

Patricia A. Hoffman

Name



Signature